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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,355	07/23/2003	Donald Howard Ellington	125710-2	8222
7590	09/14/2005		EXAMINER	
Marina T. Larson OPPEDAHL & LARSON LLP PO Box 5088 Dillon, CO 80435-5088			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/625,355	ELLINGTON ET AL.
	<b>Examiner</b> David Buttner	<b>Art Unit</b> 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 July 2005.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 9-12, 14-25, 29-35 and 37-46 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 9-12, 14-25, 29-35, 36-46 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

Art Unit: 1712

Claim 11 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The base claim already requires 50-300ppm. Note that less than “about” 300ppm widens the range MPEP 2173.05(b).

Applicant is advised that should claim 9 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The following pairs of claims are also substantial duplicates: 12,21; 14,23; 15,29; 18,34; 45,46.

Claims 17 and 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17's range is broader than that of claim 9.

Claim 19 refers to “the composition of claim 9”, but claim 9 is drawn to a process.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-12,14-25,29-35 and 37-46 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagai EP736558.

Nagai (abstract) suggests melt blending polyester and polycarbonate in the presence of a catalyst followed by adding an acidic deactivator. A single Tg results (page 3 line 19). Melt blending is conducted at 260-290<sup>0</sup> C (page 9 line 12). The acidic substance is fed from the side of the extruder after ester exchange takes place and (page 7 line 10-12). The catalyst can be zinc stearate (page 7 line 25). The acidic compound can be phosphoric acid (page 8 line 10). The amounts of catalyst can be 0.0001-1% (page 7 line 41). The amount of acidic compound is 0.001-1% (page 8 line 30). The polyester can be poly(ethylene/cyclohexanedimethanol- terephthalate) (page 5 line 37). Any combination of catalysts, stabilizers and amounts thereof within the disclosure would be obvious if not considered anticipatory.

Claims 9-12,14-25,29-35 and 37-46 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagai EP774491.

Nagai (abstract) suggests blends of polyester and polycarbonate that exhibit a single Tg. A catalyst and protonic acid are included. The catalyst can be zinc stearate

(page 7 line 45) in amounts of 0.0001-1% (page 8 line 10). The acid can be phosphoric acid (page 8 line 36) in amounts of 0.001-1% (page 8 line 48). Preferably, the acid is added using a side feeder after the other components are kneaded (page 9 line 22). Kneading is carried out at 270<sup>0</sup>C (page 10 line 11). The polyester can be poly(ethylene/cyclohexanedimethanol- terephthalate) (page 7 line 32). Any combination of catalysts, stabilizers and amounts thereof within the disclosure would be obvious if not considered anticipatory.

Applicant's arguments filed 7/23/05 have been fully considered but they are not persuasive.

Applicant argues EP736558 and EP774491 suggest broad catalyst ranges that only partially overlap the current claims and that no reference example fully meet the claim limitations.

An overlap of ranges require a finding of prima facie obviousness (MPEP 2144.05 I Overlap of Ranges). Secondly, EP774491 has examples (table 1) with the claimed catalyst amounts. Also EP736558's "particularly preferred" range of catalyst is 0.005-0.05 per hundred of polymer (page 7 line 42). This translates to a range of 50-500ppm and requires a finding of anticipation according to the guidelines of MPEP 2131.03.

An anticipatory reference need not provide anticipatory examples. Disclosed examples do not constitute a teaching away from broader disclosure (MPEP 2123). Both references clearly teach adding the acidic stabilizer at a side feeder of the extruder

after the ester exchange reaction has taken place. This is the downstream addition of stabilizer that applicant claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER  
PRIMARY EXAMINER

9/9/05

